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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,310	10/31/2003	Lisa B. Carvajal	Carvajal 101	3929

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EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p>10/699,310</p>	<p>Applicant(s)</p> <p>CARVAJAL, LISA B.</p>	
	<p>Examiner</p> <p>Kurt Fernstrom</p>	<p>Art Unit</p> <p>3712</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/31/03</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 8 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7 and 20 contain the term "about", which is indefinite. It appears that applicant is attempting to claim a range without clearly defining the boundaries of the range. Claim 8 is rejected because of the phrase "said rubber has a fabric surface". Rubber cannot have a fabric surface, or it wouldn't be rubber; the limitation should be claimed as a layer of fabric disposed over the rubber surface or something similar to make the claim limitation more clear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Middleton. Middleton discloses in Figures 1 and 6 and in column 3, line 60 to column 5, line 55 a portable device comprising a shaped mat comprising a soft material comprising cellulose and fabric which is flexible for folding. The claim limitations pertaining to the use as a timeout device for children to sit on are functional language, which describes the intended purpose of the device rather than providing any particular structural limitations to the device. Under MPEP 2114, such limitations are not deemed to have patentable weight. This is taken into account in all of the rejections below. With respect to claim 2, Middleton discloses in the Figures embodiments whereby the mat is rectangular, and circular. With respect to claim 3, Middleton discloses seams for folding the mat. With respect to claims 5 and 17, Middleton discloses certain of the claimed materials. With respect to claim 7, Middleton discloses that the pad has a thickness within the claimed range.

Claims 1, 4, 9 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Pascal. Pascal discloses in Figure 1 and in column 2, line 7 to column 3, line 31 a portable device comprising a shaped mat comprising a soft material comprising plastic and fabric which is flexible for folding. With respect to claim 4, Pascal discloses in Figure 1 and in column 2, lines 16-20 decorative indicia 20 placed on the mat. With respect to claim 9, Pascal discloses in Figure 1 that the mat is in the shape of an animal. With respect to claim 17, Pascal discloses certain of the claimed materials.

Claims 1, 2, 5, 8, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Peters. Peters discloses in Figure 1 and in column 2, line 66 to column 3, line 16 a portable device comprising a circular mat comprising a soft material comprising rubber and fabric which is flexible for folding. With respect to claims 5 and 17, Peters discloses certain of the claimed materials. With respect to claims 8 and 19, Peters discloses in column 2, line 66 to column 3, line 8 that the material comprises rubber, with a fabric covering disposed thereon.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Geddings. Geddings discloses in Figure 1 and in column 1, line 54 to column 2, line 33 a portable device comprising a rectangular mat comprising a soft material which is flexible for folding or rolling.

Claims 1, 2, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott. Scott discloses in Figures 1 and 2 and in column 3, line 36 to column 4, line 43 a portable device comprising a rectangular mat comprising a soft material which is flexible for folding or rolling. With respect to claims 14 and 15, Scott further discloses a fabric slipcover 10 which can be placed over the mat. The cover is washable, and it is also disposable. "Disposable" is a very broad term; the cover of Scott is capable of being disposed of.

Claims 1, 2, 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Hort. Hort discloses in Figures 1-4 and in column 2, line 49 to column 3, line 15 a portable device comprising a rectangular mat 20 comprising a soft material which is

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flexible for folding or rolling. With respect to claims 12 and 13, Hort further discloses a carrying bag 34 for carrying the mat.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Middleton. Middleton discloses all of the limitations of the claim with the exception of the diameter of the device. While Middleton does not disclose a mat having a diameter within the claimed range, modifying the diameter would have been an obvious variation, for smaller surgical uses.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pascal in view of Chang. Pascal discloses all of the limitations of the claims with the exception of the indicia in the form of a cartoon character. Chang discloses a mat having indicia thereon representing a cartoon character. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Pascal by providing indicia in the form of a cartoon character thereon for the purpose of making the mat more attractive to a child.

Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters. Peters discloses all of the limitations of claim 16 with the exception of the

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use of TBD. Given that Peters discloses that the material is rubber, as discussed above, TBD would be an obvious variation on the material disclosed by Peters. Peters discloses all of the limitations of claim 20 with the exception of the claimed thickness. From the Figures, it appears that the thickness is within the claimed range. To the extent that the Figures do not explicitly disclose the claimed thickness, such thickness would have been an obvious variation for the purpose of providing a mat which can be easily folded.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Geddings. Geddings discloses all of the limitations of the claims with the exception of the zipper closure. Geddings does, however, disclose in column 2, lines 11-20 a stuffed casing with a detachable closure. Official Notice is taken that zippers are a well known means of selectively opening and closing a material, and would have been an obvious variation on the device disclose by Geddes.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Alonso, Lerman, Smith, Slood, Thomas and Wang disclose various mats.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF
April 16, 2004

Kt Fet
Kurt Ferston